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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,179	12/27/2000	Kuniharu Takayama	0826.1651	2989

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EXAMINER

BEAMER, TEMICA M

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/748,179

Applicant(s)

TAKAYAMA ET AL.

Examiner

Temica M. Beamer

Art Unit

2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 6 and 9 is/are allowed.
- 6) ☒ Claim(s) 5, 7, 8, 10-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 10/19/2004 with respect to claims 5, 7, 8 and 10-12 have been fully considered but they are not persuasive.

Regarding claims 5, 7, 8 and 10-12, the applicant argues that Peters fails to disclose allowing freely settable area information to correspond to selectable service programs without requiring a service provider to pre-define a respective area for each of the selectable programs. Applicant also argues that Peters fails to disclose providing customized selectable service programs.

With regards to the first argument, the examiner disagrees. Peters discloses wherein different location areas correspond to different services offered to a user, and if a user is not located within a defined area, selected services are not allowed (col. 2, line 60-col. 3, line 5, col. 8, line 50- col. 9, line 26). Further the claim language, does not specifically indicate who "freely sets" the area information. Thus the network or the system can be the entity that defines the area information as shown in Peters (col. 3, lines 25-54).

Regarding the second argument, the claims do not call for customized selectable programs. The claims only require that a service program be selected. Peters discloses wherein a mobile station selects a service in the UMTS system, and based on the users location such selected service is granted or denied (col. 8, lines 47-49 and col. 9, lines 22-26).

Based on the above remarks, claims 5, 7, 8 and 10-12 stand rejected in view of Peters as described below.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 5, 7, 8 and 10-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Peters et al (Peters), U.S. Patent No. 6,397,072.

Regarding claims 5, 8 and 11, Peters discloses a storage device storing freely settable area information within a service coverage area and a selectable service program, the area information corresponding to the selectable service program (col. 7, lines 30-42); a communication device receiving position information of a mobile station (col. 8, lines 4-7); a decision device for making a decision of whether a position represented by the position information of the mobile station is included in an area corresponding to the selectable service program (col. 8, lines 50-56); and an execution device executing the selectable service program corresponding to the area information to provide a service to the mobile station when the position is included in the area (col. 9, lines 14-26).

Regarding claims 7 and 10, Peters discloses retrieving a specified selectable service program and area information which is stored corresponding to the specified selectable service program from a storage device storing a plurality of pieces of freely settable area information within a service coverage area and a plurality of selectable service programs for respective different services, each piece of area information corresponding to each selectable service program (col. 2, line 60-col. 3, line 5); deciding whether a position of a mobile station is included in an area represented by the retrieved area information (col. 3, lines 24-33, col. 8, lines 50-56); and executing the retrieved selectable service program to provide a service to the mobile station when the position is included in the area (col. 9, lines 14-26).

Regarding claim 12, Peters discloses linking area information within a service coverage area to the selectable service program (col. 2, line 65-col. 3, line 10); and providing the selectable service program to the mobile station (col. 8, lines 50-59); and providing the selectable service program to the mobile station upon determining that the received position information of the mobile station corresponds to the linked area information within the service coverage area of the selectable service program (col. 9, lines 18-26).

***Allowable Subject Matter***

4. Claims 1-4, 6 and 9 are allowed.

5. The following is a statement of reasons for the indication of allowable subject matter: Regarding independent claims 1, 6 and 9, prior art fails to suggest or render obvious a selection device retrieving from a storage device a selectable service program based on the service selection information and retrieving area information corresponding to the retrieved selectable program and an area decision device making a decision of whether a position represented by the position information is included in an area corresponding to the retrieved selectable program.

Regarding claims 2-4, they are indicated allowable based on their dependence from allowable claim 1.

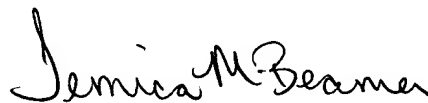
***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Beamer whose telephone number is (703) 306-5837. The examiner can normally be reached on Monday-Thursday (alternate Fridays) 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (703) 306-0003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2681

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Temica M. Beamer". The signature is fluid and cursive, with the first name "Temica" being more prominent than the last name "Beamer".

Temica M. Beamer  
Primary Examiner  
Art Unit 2681

March 6, 2005